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In the Supreme Court of the United States. O. C.

Filed Dec. 1, 1898.

THE UNITED STATES *ex rel.*
ALFRED L. BERNARDIN,
Plaintiff in Error,

vs.

CHARLES H. DUELL, Commissioner of Patents.

October Term, 1898.
No. 444.

IN ERROR TO THE COURT OF APPEALS OF THE DISTRICT OF COLUMBIA.

Reply to Brief for Assignee of William H. Northall.

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IN THE SUPREME COURT OF THE UNITED STATES.

THE UNITED STATES *ex Rel.*
ALFRED L. BERNARDIN,
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vs.
CHARLES H. DUELL, Commissioner of Patents.

October Term, 1898.
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REPLY TO BRIEF FOR ASSIGNEE OF WILLIAM H. NORTHALL.

We beg to submit the following reply to the brief of counsel for the assignee of William H. Northall.

Said brief is in substance the same and the authorities cited therein are the same as those cited in the brief for Northall filed in the Court of Appeals of the District of Columbia, and the propositions presented are in the main answered by our main brief.

That the Commissioner of Patents is not a judge, nor his office a court, but that he is an officer of the executive department, charged with duties which are executive in their character and which are not judicial in the sense of the Constitution under which judicial power can be exercised by the courts only in the cases enumerated in that instrument, is shown by the authorities cited in our main brief, more particularly following pages 11, 23, 42 and 56.

"The secretary of state is, in the act of making out patents, a mere ministerial officer, and can exercise no power which is not expressly given." (Grant *vs.* Raymond, 6 Pet., 241.)

Our brother Wilson has fallen into the error of supposing that we have overlooked Section 8 of the Constitution, which provides that "Congress shall have power to promote the progress of science and useful arts," &c. (see page 2 of Brief

for assignee of Northall), and he suggests that it is left entirely with Congress to designate or appoint the *means* or instrumentalities to which it will resort in the exercise of the power granted by said section of the Constitution.

As stated at page 57 of our main brief, there is no question that Congress is authorized to select such means as may be deemed fit and appropriate for carrying out and into effect such power, *always provided the means and agency so selected are not in contravention of the letter or spirit of the Constitution itself.* (See Brief for Plaintiff in Error, pp. 57, 58, and 61.)

We do not desire to add anything further to what has already been said in our main brief, in answer to the brief for the assignee of Northall, except in respect to the contention that another remedy is afforded by section 4915 of the Revised Statutes, and that therefore the petition for mandamus cannot be entertained.

This same question was raised, and the same authorities cited by our brother Wilson in his brief on the appeal to the Court of Appeals. In disposing of the question the court said:

* * * "Without setting out the pleadings, it is sufficient to say that they make a case in which the *mandamus* ought to issue if Congress had not the power to confer that jurisdiction." * * * (Bernardin *vs.* Seymour, 10 App. Cases D. C., 294.)

Moreover, in the case of Butterworth *vs.* Hoe, 112 U. S., 50, the writ of mandamus was granted, although the same remedy existed that is now urged against the case at bar.

The rule of law as settled does not sustain our brother Wilson's contention. That point was made in the case of Butterworth *vs.* Hoe, but this Court said, No; that the legal right of the petitioner was to have issued to him a patent, and the Commissioner was without excuse in refusing to issue it. There remained only the administrative act to prepare the patent, and the excuse for not doing so was that an *appeal* had been taken as in this case. But there was no

jurisdiction to entertain an appeal, and hence the reason given by the Commissioner for refusing to issue the patent was not tenable and the mandamus was granted.

In the case at bar, if the appellate tribunal was and is without jurisdiction it follows, of course, that the Commissioner has not offered any legal excuse for his refusal to perform the administrative act demanded, and therefore this Court will direct that he issue the patent.

Furthermore, the prerequisities which counsel for the assignee of Northall contends, at page 14 of his brief, are essential to warrant a court in granting the mandamus, are present in the case at bar, assuming, of course, that the Act of Congress conferring the right of appeal to the Court of Appeals of the District of Columbia from the decisions of the Commissioner of Patents is unconstitutional, as we respectfully submit it is, for in that event the relator has "a clear legal right to the performance of the particular act or duty at the hands of the respondent," and second, "the law affords no other adequate or specific remedy to secure the enforcement of the right and the performance of the duty which it is sought to coerce."

"Where the right is clear and specific and public officers or tribunals refuse to comply with their duty, a writ of mandamus issues for the very purpose of enforcing specific relief. It is the inadequacy and not the mere absence of all other legal remedies and the danger of a failure of justice without it that must usually determine the propriety of this writ, and it is not excluded by other legal remedies which are not adequate to secure the specific relief needed nor by the existence of a specific remedy in equity." (Am. & Eng. Encyclopædia of Law p. 102; citing LaGrange *vs.* State Treasurer, 24 Mich. 469; People *vs.* New York, 10 Wend. (N. Y.), 395; People *vs.* State Treasurer, 23 Mich. 499; Klokke *vs.* Stanley, 109 Ill., 192; Tawas, etc., R. Co. *vs.* Iosco Circuit Judge, 44 Mich, 479.)

"The mere fact that the statute provides a remedy does not, however, supersede the remedy by mandamus. The relator must not only have a specific, adequate and legal remedy, but it must be one competent to afford relief upon

the very subject-matter of his application; and if it be doubtful whether such statutory remedy will afford him a complete remedy, the writ should issue." (Encyclopædia of Law, Vol. 14, pp. 101–102; citing Freement *vs.* Crippen, 10 Cal., 211; State *vs.* Wright, 10 Nev., 167; Etheridge *vs.* Hall, 7 Port. (Ala.), 47; *In re* Trustees of Williamsburgh, 1 Barb. (N. Y.), 34; Babcock *vs.* Goodrich, 47 Cal., 488; People *vs.* State Treasurer, 24 Mich., 469.)

"By a remedy at law such as will operate as a bar to mandamus is understood such a remedy as will enforce a right or the performance of a duty, and unless it reaches the end intended and actually compels a performance of the duty in question, it is not an adequate remedy within the meaning of the rule. High on Extraordinary L. Rem., Par. 17; Overseers of Porter Twp. *vs.* Overseers of Jersey Shore, 82 Pa. St., 275." (*Ibid.*, p. 102.)

We respectfully submit that our brother's contention in regard to the equity proceeding is untenable and not sustained by the authorities, and that the writ of mandamus is the proper and only adequate remedy afforded for the enforcement of the duty sought to be enforced.

"A court of equity is sometimes resorted to as ancillary to a court of law in obtaining satisfaction of its judgments. But no court having proper jurisdiction and process to compel the satisfaction of its own judgments can be justified in turning its suitors over to another tribunal to obtain justice. **It is no objection, therefore, to the use of this remedy, that the party might possibly obtain another by commencing a new litigation in another tribunal.**" (Board of Comm. of Knox County *vs.* Aspinwall, 24 How., 385; 4 U. S., 186.)

And on the main question we further respectfully submit that the cases we have cited in our main brief, from this Honorable Court and from the Courts of the States, clearly sustain our contention.

Respectfully submitted.

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